

REMARKS

Reconsideration of the claims is respectfully solicited.

Claims 1-2, 4 and 8 were previously rejected under Section 102 over Ernest.

Starting with claim 1, it will be noted that such is recited as being used for installation in openings between studs, beams, etc... There is no disclosure in Ernest for use in any such manner. Statements of intended use in claims must be accorded patentable significance. See *In re Atwood* 148 USPQ 203 (CCPA 1966).

Claim 1 goes on to provide in a statement of intended use, that the blanket is for use between studs, etc... that are evenly spaced-apart, as well as those that are irregularly spaced-apart. Again, there is no suggestion whatever in Ernest that Ernest is intended for any such use whatever.

Claim 1 goes on to recite that the blanket has cutting guidelines for use in providing visual guidelines for cutting the blanket to size to accommodate irregular spaces between spaced-apart structural members.

There is no suggestion anywhere in Ernest that the perforations 26 of Ernest are to provide cutting guidelines in any respect. Rather, they are for venting the relatively high static pressure on one side of the blanket, through the blanket, to a lower pressure side on the other side of the blanket.

Clause (e) of claim 1 requires that the spots of adhesive be visible through the perforations at the second sheet surface of the facing sheet. This was previously also a feature in the claim, prior to the rejection. Column 4 lines 13 and 14 make it clear that the perforations 26 of Ernest are “substantially void or free of the adhesive 24”. Thus, whatever else is taught in Ernest, the spots of adhesive are not visible through the facing sheet. In fact, Ernest goes on to TEACH AWAY from this feature required by clause (e) of claim 1, in stating “conversely, if the perforations 26 were formed in the facing layer 20 prior to curing the adhesive 24, the adhesive 24 could completely or at least partially fill the perforations 26”. Since Ernest wants the perforations as a means for venting, Ernest certainly does not want or teach that its insulation blanket can, in any respect, meet the requirement of clause (e) of claim 1.

Prior art that teaches away from an invention is not capable of fairly suggesting that invention. See *In re Bell* 26 USPQ 2d 1529, 1531 (Fed. Cir., 1993), *WL Gore &*

Associates, Inc. v. Garlock, Inc. 220 USPQ 303, 311 (Fed. Cir., 1984). In *Gore* the court held that the District Court erred in disregarding the fact that disclosures in the references diverged from and taught away from the invention at hand. The United States Supreme Court is in accord that disadvantages in prior art do not negative patentability. *United States v. Adams* 148 USPQ 479 (1966).

Claim 1 clause (f) goes on to require as a matter of structure that the grid of perforations comprise means defining generally straight, predetermined cut lines for cutting the facing sheet and insulation in accordance with a pattern defined by at least some of the spots of adhesive. There is no such teaching whatever in Ernest, that the perforations 26 are to provide cut lines.

For all of the above reasons, it is submitted that claim 1 should be allowable, as should claims 2, 4 and 8. Claim 8, while being a method claim, includes almost all of the features set forth in claim 1, albeit in method format.

Claim 3 should be allowable for all the reasons set forth above with respect to claim 2. Its rejection as being unpatentable over Ernest in view of Broderick should be withdrawn for all of the above-mentioned reasons. The use of Broderick in the combination for disclosing asphalt does not add to the deficiencies of the rejection as applied to the rest of claim 3. The asphalt is not used in Broderick, to show through perforations, to provide cutting guidelines.

The rejections of claims 5-7 over Ernest under Section 103, because of the dimensional relationships recited, should likewise be withdrawn for all of the reasons addressed above.

Claim 9 depends from claim 8 and additionally requires the step of cutting the blanket along the perforations and fastening the blanket between structural members. Again, nothing in Ernest suggests using the perforations 26 as cut guidelines. Furthermore, nothing in Ernest suggests applying a blanket thus cut to a predetermined spacing between structural members, regularly or irregularly spaced.

Support for the amendments to the claims is present in pages 2-4 of the specification, *inter alia*.

Allowance of all the claims is respectfully solicited.